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PATENT

Attorney Docket No.: 2870/72

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shah

Serial No.: 09/248,524

Group Art Unit: 1617

Filed: February 9, 1999

Examiner: Berman, Alysia

For: Long-Wearing Cosmetic Compositions

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7-12-02

RESPONSE PURSUANT TO 37 CFR 1.113

The Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

In the Examiner's Office Action of April 9, 2002, the claims of the present invention are rejected for indefiniteness and obviousness. Beginning with the first indefiniteness rejection, the Examiner still finds that the term "long-wearing" is not clear and concise. In particular, the Examiner asserts that the description of "long-wearing" in the specification as providing use as an art form on the skin for up to a full day does not encompass a shorter length of time, and therefore, one skilled in the art cannot determine a clear and concise definition. However, the requirements of 112 do not require a lower limit to a range when describing the terms used in the claims. In this setting, as the court found in *Modine Mfg. v. U.S. Int'l Trade Comm'n*, mathematical precision is not always required—only a reasonable degree of particularity and definiteness. *Exxon Research and Engineering Co. v. United States*, 60 USPQ2d 1272 1281 (CAFC 2001) (see *Modine Mfg. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545, 1557, 37 USPQ2d 1609, 1617 (Fed. Cir. 1996)). The term long-wearing is inherently focused on the length, not the shortness, of time that the composition lasts. In addition, the specific noting of a minimum length of time is not necessary because if the composition lasts for a day it necessarily lasts anytime less than a day that the user may desire. Therefore, one of ordinary skill in the art would recognize the description in the present specification as being clear and concise.

The second term found by the Examiner to be indefinite is the word "derived." The Examiner still finds that the specification does not provide an exclusive definition. However, in addition, there is no basis in the patent laws or regulations for an exclusive definition, nor has the Examiner provided a citation for an exclusive definition. Applicants, in applying the standards of 112, argued that the polymers encompassed by the present invention are described in the

present specification. In addition, the word "derived" is one, in the context of polymers, that one of ordinary skill in the art would understand. Applicants attach herewith copies of claims using the word "derived" in the context of polymers as one of ordinary skill in the art would understand its use. The description in the present specification provides sufficient and ample guidance as to the what an acrylic acid derived polymer or copolymer is. An acrylic acid derived polymer is just that and one skilled in the art can determine which if any substituents are within the scope of the present invention. It is not necessary for a description in a specification to describe that which one of ordinary skill in the art would know and understand.

The Examiner again finds that the '072 reference and the '277 reference render Claims 1 to 21 under 35 U.S.C. §103(a). This rejection as noted by the Examiner was last addressed by Applicants in their response of August 9, 2001. The Examiner finds motivation to combine these references from the desire to obtain an aqueous colored composition in which the pigments are dissolved so the composition will flow through the wick of a nib pen without clogging. As Applicants previously mentioned in their Response of December 5, 2000, some of the particular disadvantages of incorporating waxes, oils and fats, include most importantly clogging. Not only does one of ordinary skill understand the lack of ability and challenges of trying to add water-soluble pigments to an emulsion, but the '277 reference supports this at column 1, lines 22 to 31, where the '277 reference clearly explains that oil causes clogging. Therefore, motivation to combine these two references is not found in the cited references. Rather, the '277 reference teaches away from such a combination. There has not been a response to this argument presented by the Examiner. It has been noted by the court in *McGinley v. Franklin Sports Inc.* that as a "useful general rule," references that teach away cannot serve to create a *prima facie* case of obviousness. *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (CAFC 2001)(citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994)).

The '277 reference fails to teach or suggest the polymeric component of the present invention, and the '072 reference fails to teach or suggest water-soluble pigments, therefore, they each alone fail to render the present invention obvious. The compositions of the present invention utilize a simple acrylic or methacrylic acid derived polymeric system that permits the beneficial use of water soluble pigments without the drawbacks of fading and running. As the Examiner points out water-soluble components may be used according to the teachings of the '277 reference. However, there is no teaching or suggestion in either reference as to how to avoid the problem of running if in fact the problem of clogging is resolved. The ability to overcome both of these challenges is achieved with the compositions of the present invention,

and is not taught or suggested by the cited references. It can be seen from both the '072 and the '277 references that fairly elaborate polymeric systems are taught to stabilize the compositions. Therefore, the methods of the present invention in preparing the compositions by a simple combination of the acrylic or methacrylic acid derived polymer with the water soluble organic pigments are not taught or suggested by the cited references.

Because there is no motivation to combine the '072 and the '277 references and because the combination of these cited references fail to teach or suggest the present invention, Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a), and Applicants request that the rejection under 35 U.S.C. §103(a) be withdrawn.

#### CONCLUSION

Accordingly, the claims are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

Date July 9, 2002



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